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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/552,820	10/11/2005	**Bernhard Gleich**	DE 030115	5543

24737 7590 07/22/2011

PHILIPS INTELLECTUAL PROPERTY & STANDARDS
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EXAMINER
MEHTA, PARIKHA SOLANKI

ART UNIT	PAPER NUMBER
3737	

NOTIFICATION DATE	DELIVERY MODE
07/22/2011	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/552,820	GLEICH, BERNHARD	
	Examiner	Art Unit	
	PARIKHA MEHTA	3737	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 March 2011*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *2-18,20-22 and 25* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *2-18,20-22 and 25* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Request for Additional Information under 37 CFR 1.105

1. Examiner notes that the '681 patent discussed below, originally filed as US Patent Application 10/270,991, claims priority to DE 10151778, filed 19 Oct 2001. It was not possible to obtain information regarding the publication date of this foreign application at the time of writing of this Office Action. Of concern is the fact that publication of the foreign application may have occurred more than one year prior to the domestic filing of the present application, thus constituting art under 35 U.S.C. 102(b) which must fairly be applied as prior art under 35 U.S.C. 103(a) on all presently pending claims for reasons similar to those discussed for the '681 patent herein. Applicant is requested to provide the earliest publication of this foreign application in an IDS accompanying any subsequent reply to this action, so as to resolve whether an additional matter of unpatentability of all pending claims under 35 U.S.C. 103(a) exists.

2. A large number of double patenting rejections are made herein. While every attempt was made at finding all related pending and patented applications made by the present inventor, Examiner requests Applicant to confirm that no other conflicts exist by making of record any additional applications or patents not cited herein which are similarly directed towards methods and systems of generating a magnetic field having two sub-areas which are shifted such that a zero crossing of one of the areas also moves. To expedite prosecution, if Applicant believes such additional applications/patents do not present double patenting conflicts, Applicant is requested to include a detailed explanation of the novel advances of the present invention relative to any and all of those applications/patents with any subsequent response to this office action.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would

have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 2-18, 20-22 and 25 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-7 and 9-14 of U.S. Patent No. 7,300,452. Although the conflicting claims are not identical, they are not patentably distinct from each other because they merely claim obvious variations and groupings of the same invention. Although the conflicting claims do not recite the presently claimed reduction of agglomeration, such step (and, similarly, element used to achieve such step) does not materially limit the manner in which the present method is performed. Furthermore, the presently claimed particle sizes and field strengths are obvious in view of the conflicting claims directed towards tailoring the magnetic substance parameters to a particular tissue.

5. Claims 2-18, 20-22 and 25 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-10 of U.S. Patent No. 7,351,194. Although the conflicting claims are not identical, they are not patentably distinct from each other because they essentially claim the same elements and steps, with the exception of the present recitation of agglomeration reduction, which is not a patentable advance for reasons similar to the discussion of the '452 patent above. Regarding the present claim limitations directed towards the particle size and field strength, such optimization of ranges and change in size and/or shape of a claimed element has previously been held to be obvious and unpatentable (*Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984); *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966); *In re Hoeschele*, 406 F.2d 1403, 160 USPQ 809 (CCPA 1969)).

6. Claims 2-18, 20-22 and 25 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1-3, 8, 9 and 11-25 of U.S. Patent No. 7,747,304. Although the conflicting claims are not identical, they are not patentably distinct from each other because they merely differ in their essential steps and structure by the presently claimed agglomeration reduction, particle size and field strength, which are not novel advances for reasons similar to those discussed above for the '194 and '452 patents.

7. Claims 2-18, 20-22 and 25 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-17 of U.S. Patent No. 7,778,681. Although the conflicting claims are not identical, they are not patentably distinct from each other because they merely differ in their essential steps and structure by the presently claimed agglomeration reduction, particle size and field strength, which are not novel advances for reasons similar to those discussed above for the '194 patent.

8. Claims 2-18, 20-22 and 25 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3, 5-7 and 20 of copending Application No. 10/552,774 (conflicting claims considered as of the filing of 10 Jun 2008; see also US PG Pubs. No. 20060238194, presently made of record). Although the conflicting claims are not identical, they are not patentably distinct from each other because they merely claim obvious variations and groupings of the same elements and steps, wherein the conflicting "use" claim, although improper in its form of dependence, is considered in terms of its apparent intended meaning, which is interpolated to essentially be a method of using the apparatus of conflicting claim 1. Although the conflicting claims do not expressly recite steps and elements for reducing agglomeration, the conflicting disclosure clearly describes the conflicting invention as being effective for achieving such result (see at least paragraph 49).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

9. Claims 2-18, 20-22 and 25 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 8-14 of copending Application No. 10/552,808 (conflicting claims considered as of the filing of 24 May 2010; see also US PG Pubs. No. 20060238194, presently made of record). Although the conflicting claims are not identical, they are not patentably distinct from each other because they merely claim obvious variations and groupings of the

same elements and steps, wherein the presently recited reduction of agglomeration does not patentably distinguish the present invention because it does not materially change the structure of the presently claimed apparatus to differ from the conflicting apparatus. Furthermore, although the conflicting claims do not recite a method, the presently claimed method cannot be carried out with any other device; in other words, since the present method and conflicting apparatus are inextricably linked.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

10. Applicant's arguments, see Appeal Brief, filed 10 March 2011, with respect to the rejection(s) of claim(s) 2-18, 20-22 and 25 under 35 U.S.C. 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of the double patenting conflicts detailed herein. Examiner notes that an attempt was made to contact Applicant's representative to seek resolution by phone prosecution on 14 July 2011, but such attempt did not result in any agreement. Upon further consideration, given the large number of outstanding double patenting conflicts, it does not appear that phone prosecution would be appropriate or effective at this time.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PARIKHA MEHTA whose telephone number is (571)272-3248. The examiner can normally be reached on M-F, 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on 571.272.4956. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Parikha S Mehta/
Primary Examiner, Art Unit 3737